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**OCT 12 2006**

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In re Application of: Blackwell, et al.	)
Application No. 09/870,418	) DECISION ON PETITION FOR
Attorney Docket No. C1104.70001US00	) SUPERVISORY REVIEW REGARDING
Filed: May 30, 2001	) FINALITY OF RESTRICTION
For: METHOD AND APPARATUS FOR	) REQUIREMENT UNDER 37 CFR
AUTHORING AND PLAYING BACK	) §1.181 and 37 CFR §1.144
LIGHTING SEQUENCES	)

This is in response to the petition filed on May 12, 2006, under 37 CFR 1.144 requesting supervisory review of the finality of a restriction requirement mailed on November 1, 2005. Note, a petition under 37 CFR §1.144 will not be considered if reconsideration of the requirement was not requested (see §1.181).

The petition is **GRANTED**.

**RECENT PROSECUTION HISTORY**

- (1) A non-final first office action on the merits was mailed on February 9, 2005, in which all pending claims (1-84) were rejected on prior art.
- (2) An amendment was filed on August 11, 2005. Claims 1, 2, 4, 5, 8, 11-16, 20, 30, 32, 33, 37, 41, 42, 45-53, 55, 57 & 63-67 were amended, while claims 3, 7, 31, 34, 39, 40, 44, 62 & 68-84 were cancelled.
- (3) In response to amendment, the Examiner mailed a combination restriction requirement and species election on November 1, 2005. In the restriction, the Examiner grouped the claims according to the following: Group I – drawn to claims 1, 2, 5, 6, 8-29, 30, 33, 35-38, 42, 43 & 45-61; Group II – drawn to claims 4, 32 & 41; Group III – drawn to claims 63 & 65; Group IV – drawn to claims 64 & 66; and Group V – indicated to be drawn to claim 65\*; and in the species election, within Group I - three different species were identified as follows: Species A – input from an external device; Species B – input from a user; Species C – input from a sensor.
- (4) On November 22, 2005 and in response to the combination restriction and species election of November 1, 2005, Applicant provisionally elected Group I (claims 1, 2, 5, 6, 8-29, 30, 33, 35-38, 42, 43 & 45-61) and species A (claims 8, 11-13, 45-50 & 57). The election was

\* believed to be a typo, should apparently be claim 67.

made with traverse wherein Applicant provided supporting arguments for the traversal along with a request for withdrawal of the restriction requirement.

(5) On February 23, 2006, the Examiner mailed a final Office action acknowledging Applicant's election with traverse of claims 1, 2, 5, 6, 8, 11-13, 17-20, 30, 33, 36, 37, 42, 45-50, 54, 55, 57, 60 & 61. The Examiner withdrew claims 4, 9, 10, 14-16, 21-29, 32, 35, 38, 41, 43, 51-53, 56, 58, 59 & 63-67. This office action determined the requirement for restriction to be proper and therefore was made FINAL.

(6) On May 12, 2006, the instant petition was filed by Petitioner under 37 CFR §1.144.

(7) On May 26, 2006, an amendment and remarks were filed. Subsequently, on July 31, 2006, replacement drawing sheets were filed.

(8) On September 26, 2006, an advisory action was mailed indicating the amendment filed May 26, 2006 will not be entered.

### RELIEF REQUESTED

The instant petition under 37 CFR §1.144 requests the following relief:

- (1) withdrawal of the restriction requirement and species election of November 1, 2005; and
- (2) as a result of item (1) above, examination of the pending claims.

### ANALYSIS

Petitioner provides various arguments in support of the withdrawal of the election/restriction requirement including reference M.P.E.P. § 803.

#### Restriction Requirement

First, an analysis with respect to the proposed restriction requirement under 35 U.S.C. 121 (subcombinations disclosed as usable together (Groups I – V) set forth by the Examiner in the Office action mailed November 1, 2005) will be proffered:

M.P.E.P. § 803 (Restriction – When Proper) states in part:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent (see MPEP § 802.01, § 806.06, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(j)); and
- (B) There would be a serious burden on the examiner if restriction is not required (see MPEP § 803.02, § 808, and § 808.02).

For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02.

M.P.E.P. § 808 (Reasons for Insisting Upon Restriction) states:

Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why each invention as claimed is either independent or distinct from the other(s); and (B) the reasons why there would be a serious burden on the examiner if restriction is not required, i.e., the reasons for insisting upon restriction therebetween as set forth in the following sections.

M.P.E.P. § 808.02 (Establishing Burden) sets forth:

Where the related inventions as claimed are shown to be independent or distinct under the criteria of MPEP § 806.05(c) - § 806.06, the examiner, in order to establish

reasons for insisting upon restriction, must >explain why there would be a serious burden on the examiner if restriction is not required. Thus the examiner must< show by appropriate explanation one of the following:

- (A) **Separate classification thereof** : This shows that each **>invention<** has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.
- (B) **A separate status in the art when they are classifiable together** : Even though they are classified together, each **>invention<** can be shown to have formed a separate subject for inventive effort when **>the examiner can show<** a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.
- (C) **A different field of search** : Where it is necessary to search for one of the **>inventions in a manner that is not likely to result in finding art pertinent to the other invention(s)** (e.g., searching different classes /subclasses or electronic resources, or employing different search queries<, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

Finally, M.P.E.P. § 811 states in part:

a restriction requirement “will normally< be made before any action upon the merits; **however, it may be made at any time before final action >>.”** This means the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops.

Contrary to Applicant’s remarks that the language of the amended claims is “identical to” or “closely mirrors” the language previously searched and examined, an analysis of the restriction requirement (before the Applicant) shows the Examiner appears to have met the necessary criteria required (M.P.E.P. 803 and 808) by providing reasons for the claimed invention, defined by Groups I – V, as distinct (i.e. “subcombinations useable together”) and has established burden, in accordance with M.P.E.P. 808.02, i.e. defined the inventions as having “acquired a separate status in the art as shown by their different classification”, as identified in the Office action. Thus the November 1, 2005 Office action sets forth the necessary criteria and to define a proper restriction requirement, and was set forth prior to final action, in accordance with the M.P.E.P. and current office practice.

#### Species Election

Second, an analysis with respect to the Election of Species under 35 USC 121, set forth by the Examiner in the Office action mailed November 1, 2005, will be proffered:

37 CFR §1.146 states:

***In the first action*** [emphasis added] on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable. However, if such application contains claims directed to more than a reasonable number of species, the examiner may require restriction of the claims to not more than a reasonable number of species before taking further action in the application.

M.P.E.P. § 806.03 (Single Embodiment, Claims Defining Same Essential Features) states in part:

**Where the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction therebetween should never be required.** This is because the claims are **>not directed to distinct inventions; rather they are<** different definitions of the same disclosed subject matter, varying in breadth or scope of definition.

M.P.E.P. § 706.07(e) (Withdrawal of Final Rejection - General) states:  
When a final rejection is withdrawn, all amendments filed after the final rejection are ordinarily entered.

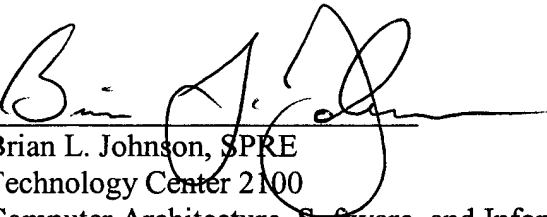
Note, the species election of November 1, 2005 was presented to the Applicant by the Examiner subsequent to the first office action, non-final rejection (of all pending claims) of February 9, 2005. In addition, and consistent with Petitioner's remarks, the limitations identified by the Examiner in Species A-C appear to have been presented in the original claims, which included a complete action on the merits. Thus, and in accordance with M.P.E.P. §806.03 and 37 CFR §1.146, the species election appears to be improper and extraneous. Since Applicant elected Group I, which included the species election (i.e. election of Species A), the restriction requirement including the species election is deemed to be improper.

### CONCLUSION

The petition is **GRANTED**. The election/restriction requirement of November 1, 2005 is hereby **WITHDRAWN**.

The application is being forwarded to the Tech. Support Staff to **WITHDRAW** the finality and for **ENTRY** of the amendment filed May 26, 2006, in accordance with MPEP § 706.07(e). Thereafter, the application will be forwarded to the Examiner to reopen prosecution and appropriate action i.e. prosecution of the pending claims consistent with this decision.

Any inquiries related to this decision may be directed to the undersigned at (571) 272-3595.



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